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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,221	07/15/2003	Gary A. Koppel	22064-71990	8706
23643 7590 08/19/2009 BARNES & THORNBURG LLP 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204				
EXAMINER				
ROYDS, LESLIE A				
ART UNIT		PAPER NUMBER		
1614				
NOTIFICATION DATE		DELIVERY MODE		
08/19/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

indocket@btlaw.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/620,221

Applicant(s)

KOPPEL, GARY A.

Examiner

LESLIE A. ROYDS

Art Unit

1614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 August 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 07 August 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 2,3,5,6 and 11.
Claim(s) withdrawn from consideration: 1,4,7-10 and 12-17.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

/Ardin Marschel/
Supervisory Patent Examiner, Art Unit 1614

/Leslie A. Royds/
Patent Examiner, Art Unit 1614

Continuation of 3. NOTE:

Applicant's proposed after-final amendment and Terminal Disclaimers filed August 7, 2009 will not be entered into the record because the entry of such documents would require further consideration and/or search.

In particular, it is noted that the instant claims were examined insofar as they read upon the originally elected subject matter of methods for enhancing cognitive function and the species of dementia, clavalanic acid and a specific P-glycoprotein efflux pump inhibitor as summarized at p.3 of the Office Action dated May 21, 2008. However, the proposed submission of the Terminal Disclaimers, if such Disclaimers were acceptable, would then necessitate the expansion of examination to other non-elected subject matter that was not previously searched and/or considered during the course of prosecution. As a result, entry of the proposed after-final submission would necessitate the search and consideration of the additional species recited in the claims, which is considered a new issue, because additional assessments of the prior art would need to be performed to determine whether additional prior art would need to be applied to these other species that were not previously search and/or examined. Accordingly, the amendments will not be entered into the record.

In addition, the proposed claim amendments are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal because they raise new issues that require further consideration and/or search.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant again requests reconsideration of the double patenting rejections, opining that the illustrative embodiments of terms used in the patent claims as found in the patent disclosures do not define the boundaries of that term unless it is clear from the disclosure that the term should be so limited.

This argument is, and will remain, unpersuasive. The fact that the patent states that a term used in the patent claims may include several embodiments, one of which is identical to the compound and/or disorder that is instantly claimed, is still clearly a definition, at least in part, of the term. Applicant's position to the contrary is not understood. It may very well be (and is admittedly true in the instant case) that there exist other definitions to the claim terms as well (e.g., that the claimed term of "disorders that may result in or from loss of neuronal cells or loss of neuronal function" includes dementia as well as epilepsy, Alzheimer's disease, etc.), but such a fact most certainly does not negate the definition of the term upon which the rejection relies to demonstrate that the claimed subject matter of the cited patents and that of the instant claims is clearly conflicting. For these reasons and those already of record, the rejections stand.

Continuation of 13. Other:

Note that the Terminal Disclaimers filed August 7, 2009 with the after-final submission were filed in response to the double patenting rejections that were originally set forth in the Office Action dated May 21, 2008 and repeated in the final rejection dated February 9, 2009. Applicant provides no reasons or explanation as to why these TDs are necessary and were not earlier presented, since the double patenting rejections have been maintained since May 2008. Accordingly, the TDs are not considered to be timely filed and are, therefore, not entered into the record.

/Leslie A. Royds/
Patent Examiner, Art Unit 1614